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OFFICE OF THE STAFF JUDGE ADVOCATE
U.S. ARMY MEDICAL RESEARCH AND MATERIEL COMMAND
ATTN: MCMR-JA (MS. ELIZABETH ARWINE)
504 SCOTT STREET
FORT DETRICK, MD 21702-5012

EXAMINER

SOTOMAYOR, JOHN

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/829,007
Filing Date: April 10, 2001
Appellant(s): RASCHE ET AL.

MAILED
DEC 21 2004
GROUP 3700

George A. Metzenthin
CAHN & SAMUELS, LLP
2000 P Street, NW, Suite 200
Washington, DC 20036-6924
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 6, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 4-8,10,12-18 and 20-28; claims 9 and 19; claims 2 and 3, and claims 11 and 35-40 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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6283923	Finkelstein et al	9-2001
5879163	Brown et al	3-1999
6375469	Brown	4-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,4-8,10,12-18 and 20-28 rejected under 35 U.S.C. 102(e). This rejection is set forth in a prior Office Action, mailed on April 21, 2003.

The Finkelstein et al patent has been cited as it addresses the same problem as that addressed by the appellant's application. The need for asthma sufferers to assess their condition on an ongoing basis without having to visit a medical practitioner on a daily basis is a boon to asthma sufferer and medical practitioner alike. Finkelstein et al addresses this problem by providing a means for questioning a user about the severity of asthma symptoms, accumulating a score based upon the answers to those questions which is correlated to at least one indicator level for asthma symptoms and informs the user, as well as the remotely located medical practitioner, of the result. The means disclosed by Finkelstein et al also provides for educating a user about

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asthma. The means recited by Finkelstein et al includes a network communication channel for distributing an interactive testing and educational software module to a user's computer system and interacting with a user through the computer based test to accumulate diagnostic information and scoring, retain said information in a data repository, and provide for the education of the user with information disseminated from a medical practitioner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finkelstein et al.

Regarding claim 9, Finkelstein et al discloses multiple scores and indicators (Col 7, lines 8-20), but does not specifically disclose that the indicator levels include severity level, compliance level, and performance level. However, Finkelstein et al does discuss providing a score for severity level (Col 6, lines 19-20) as one of the indicators for which a score is accumulated. Finkelstein et al also discusses issues of compliance and performance that are discussed between a patient and doctor as a result of the system asthma testing (Col 7, lines 21-37). In addition, Finkelstein et al provides for a self-test process over the Internet in which the test is performed by the patient and the results provided directly to the patient (Col 4, lines 44-45, Col 8 and 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide an asthma monitoring system as disclosed by Finkelstein et al with an ability to provide indicators that include severity level, compliance level and performance level to provide better asthma information to the user, including modifying scores as taught by Finkelstein et al for the purposes of better reflecting the threshold levels for alerts provided to a patient utilizing the self-test capability to allow a user to seek medical attention in a timely fashion.

Regarding claim 19, Finkelstein et al discloses a method of receiving answers to questions at the decision support server (Col 6, lines 65-68), which are then used to formulate

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alert status from background information. These alert status parameters may be changed dynamically to personalize them to a particular patient as a result of the answers received to assessment questions (Col 7, lines 1-20). Finkelstein et al also provides for a self-test process over the Internet in which the test is performed by the patient and the results provided directly to the patient allowing the patient to consult upon the information provided, including scores (Col 4, lines 44-45, Col 8 and 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide an asthma monitoring system as disclosed by Finkelstein et al with a means for personalizing the questions asked of individual patients in order to form personalized status alerts in a dynamic fashion, including modifying scores as taught by Finkelstein et al for the purposes of in order to better reflect the personal threshold levels for alerts required by a patient utilizing the self-test capability.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finkelstein et al in view of Brown et al (US 5,879,163).

Regarding claim 2, Finkelstein et al discloses the accumulation of multiple scores for multiple indices (Col 7, lines 8-20), but does not specifically disclose randomizing the order of the questioning asked by the system. However, Brown et al (163) teaches a questionnaire generator to allow users of the system to design and implement questionnaires for accumulating answers to health related questions (Col 4, lines 53-64). The Examiner takes official notice that an individual who is composing a questionnaire may place questions in any order, including a random order. Therefore, it would have been obvious to one of ordinary skill in the art to provide an asthma monitoring system as disclosed by Finkelstein et al that allows questions to be placed in random order when utilizing the means of questionnaire generation and for

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accumulating multiple scores for multiple indicators as taught by Brown et al (163) and Official Notice for the purposes of providing for a better physician's treatment plan for a particular patient by optimizing the questions asked and indicator scores recorded.

Regarding claim 3, Finkelstein et al discloses multiple scores and indicators (Col 7, lines 8-20), but does not specifically disclose that the indicator levels include severity level, compliance level, and performance level. However, Finkelstein et al does discuss providing a score for severity level (Col 6, lines 19-20) as one of the indicators for which a score is accumulated. Finkelstein et al also discusses issues of compliance and performance that are discussed between a patient and doctor as a result of the system asthma testing (Col 7, lines 21-37) and that alert parameters may be preset for a plurality of test parameters, suggesting that multiple parameters are provided for in the testing scenario (Col 7, lines 8-12). Therefore, it would have been obvious to one of ordinary skill in the art to provide an asthma monitoring system as disclosed by Finkelstein et al to provide indicators that include severity level, compliance level and performance level as taught by Finkelstein et al for the purposes of disseminating better asthma information to the user for the treatment of each individual's asthma symptoms.

Claims 11 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finkelstein et al in view of Brown (US 6,375,469).

Regarding claim 11, Finkelstein et al discloses that a user is provided with asthma education through a display in communication with a network (Col 3, lines 2-20). Finkelstein et al does not specifically disclose that the educational material is presented in a multimedia form. However, Brown (469) teaches that educating users may be accomplished by providing

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personalized health information to users through a display device and a multimedia processor (Col 3, lines 22-34). Therefore, it would have been obvious to one of ordinary skill in the art to provide asthma education through a display in communication with a network as disclosed by Finkelstein et al to users of the system in a multimedia format as taught by Brown (469) for the purposes of providing vital health information to the user over a network in an entertaining form and format to increase understanding and assimilation of the information provided.

Regarding claims 35 and 36, Finkelstein et al does not specifically disclose that there are two scored indicators (claim 35) or that the indicators include severity level, compliance level, and a performance level (claim 36). However, Finkelstein et al does provide for a plurality of alert parameters, besides severity level, in which level must be known in order to trigger an alert (Col 7, lines 8-12) and Brown (469) teaches that measures for a compliance level and a performance level must be accumulated to assist in educating an asthma sufferer (Col 10, lines 8-24). Therefore, it would have been obvious to one of ordinary skill in the art to provide asthma education through a display in communication with a network as disclosed by Finkelstein et al to provide a health assessment method with a plurality of scorable indicators wherein the indicators included severity level, compliance level and a performance level as taught by Brown (469) for the purposes of delivering a robust assessment tool that a patient may use independently to determine how to better manage their health condition.

Regarding claim 37, Finkelstein et al discloses a method in which a plurality of indicators, such as alert level, may be changed dynamically (Col 7, lines 11-14).

Regarding claim 38, Finkelstein et al discloses a method in which the answers to questions provided by a patient are stored in a data repository (Col 4, lines 39-40).

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Regarding claim 39, Finkelstein et al discloses a method in which background information questions are asked of the patient, who then supplies the answers to these questions and the data is stored in the data repository (Col 4, lines 28-40).

Regarding claim 40, Finkelstein et al discloses a method designed to provide data information exchange to educate a user about asthma (Col 3, lines 17-20).

(11) *Response to Arguments*

Group 1:

Regarding Appellant's arguments concerning the first group of claims, the Appellant asserts that the means-plus-function language of claim 1, which recites "means for questioning the user regarding the patient", contains the limitation read from the specification that the questioning must take place during a single sitting. For support Appellant relies upon the recitation in the specification, page 15, paragraph 57, which recites, in part, "the assessment may be utilized during each visit to the doctor...or even at regular intervals by the patient at home." However, the specification and claim are both silent as to a timeframe for asking any set of questions of a user of the system. Finkelstein et al recites a means for accumulating a score based on answers to questions provided to a user (Col 8, lines 55-60). Accumulating a score based upon multiple questions does not necessarily mean that the questions must be asked in single sitting, as asserted by Appellant, and, in fact, as demonstrated in the interview with Appellant on December 10, 2002, the question and answer session may be paused while a user gets up from the session, attends to other tasks, then returns to complete the session. This

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demonstrates that the timeframe for a question and answer session is not restricted to a single sitting as asserted by Appellant.

In addition, applicant presents the arguments that claim 1 combines indicators to produce a composite score, and that Finkelstein et al does not disclose a “means for informing the user of the at least one indicator”. The language of claim 1 does not disclose or suggest that there are multiple components to the “at least one indicator” that is being scored, so there is no support for the argument that the “at least one indicator” is a composite of symptoms contained in that one indicator. Also, Finkelstein et al does disclose a means of informing a user of the at least one indicator in columns 4, 8 and 9 while discussing the self-testing option provided for in the reference.

The applicant presents the argument that the Finkelstein et al reference does not teach or suggest “incrementing a score for at least one indicator based on the answer to the question” as is presented in claim 6. The applicant argues that there is no reason in the Finkelstein et al reference for incrementing the score as each diary question is a separate entity, scored separately. However, Finkelstein et al does disclose incrementing scores in the discussion of trend analysis in column 10. Trend analysis cannot be performed without incrementing and accumulating a set of scores to perform an analysis upon. Therefore, the Finkelstein et al reference does disclose and suggest the claimed limitations in claims 6 and 8.

Regarding claim 16, applicant presents the argument that the Finkelstein et al reference does not disclose the combining of answers to different questions to come up with a grade according to a predetermined scale. The language in claim 16 does not provide for such a limitation. Simply stating that there are “at least answers to two questions that will result in the

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indicator” as recited in the claim does not show the combining of different questions to devise a grade. This language does not preclude the combination of two questions of the same type answered in different sessions being used to devise a grade, which is recited in Finkelstein et al and, therefore, anticipates claim 16.

Regarding claim 22, Finkelstein et al discloses that information concerning asthma and its treatment may be provided to a patient based upon the patient’s indicator scores (Col 7, lines 34-37). Any information concerning asthma treatment is educational for an individual undergoing said treatment. Claim 22 does not invoke means-plus-function as set forth in 35 U.S.C. 112, sixth paragraph and therefore, does not invoke means from the specification. Therefore, the limitation recited in claim 22 is anticipated by the Finkelstein et al reference.

Group 2:

Appellant presents the argument that Finkelstein et al does not anticipate claim 9 as it does not recite “at least one indicator includes at least one of a severity level, a compliance level, and a performance level” to develop an indicator. However, Finkelstein et al does discuss providing a score for severity level (Col 6, lines 19-20) as one of the indicators for which a score is accumulated. Finkelstein et al also discusses issues of compliance and performance that are discussed between a patient and doctor as a result of the system asthma testing (Col 7, lines 21-37) which is a direct result in response to symptom diary question answers. Thus, Finkelstein et al teaches the limitation expressed in claim 9.

Appellant presents the argument that Finkelstein et al does not anticipate claim 19 as it does not recite “personalizing the assessment questions based on the at least one answer received for each of the at least one background information questions.” However, Finkelstein et al

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discloses a method of receiving answers to questions at the decision support server (Col 6, lines 65-68), which are then used to formulate alert status from background information. These alert status parameters may be changed dynamically to personalize them to a particular patient as a result of the answers received to assessment questions (Col 7, lines 1-20) which provides for a list of personalized alerts for each user and a corresponding personalization of the questions asked to assess the alert parameters. Thus, Finkelstein et al teaches the limitation expressed in claim 19.

Group 3:

Regarding claims 2 and 3, Appellant argues that neither Finkelstein et al nor Brown et al teach that “answers to different questions are combined to devise a grade according to a predetermined scale.” However, the Examiner has pointed out to Appellant in the Final Office action that claims 2 and 3 do not recite such a limitation and that the cited references do teach and suggest the claim limitations.

Group 4:

Regarding claim 11, Appellant argues that the prior art does not teach the utilization of multimedia presentations for presenting educational information to the user. The Brown (469) reference recites this teaching and the combination of the Finkelstein et al and Brown (469) references teach all of the recited claim limitations.

Regarding claim 35, Appellant argues that alert parameters are not indicators and that, therefore, Finkelstein et al does not provide an obviousness rejection for the claim. However, alert parameters are set and used as measurements of a patient’s physical condition and are, therefore, indicators used to alert a patient and a medical practitioner of a patient’s need for

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further treatment. Finkelstein et al provides for a plurality of these indicators of a patient's condition, besides a scored severity level, that may be adjusted by a patient's physician to better provide thresholds for alerts of the patient's condition based upon questions asked by the physician as to the patient's wellbeing (Col 7, lines 8-12). Therefore, it is obvious that Finkelstein et al provides a plurality of indicators that may be adjusted for comparison against a predetermined scale, as represented by FVC parameter settings, to better provide for a patient's wellbeing.

Regarding claims 35-40, Appellant also argues that the Examiner has failed to set forth a proper rejection of claims 35-40. However, all claims were examined and claim rejections provided to Appellant in the Final Office Action as required under 35 U.S.C. 103.

As can be seen, the examiner has provided a proper prima facie case of anticipation and obviousness in denying the patentability of the presented claims.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

jls
December 10, 2004

Conferees


Derris Banks
Supervisory Patent Examiner, AU3714


Xiuan Thai
Supervisory Patent Examiner, AU3713

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U.S. ARMY MEDICAL RESEARCH AND MATERIEL COMMAND
ATTN: MCMR-JA (MS. ELIZABETH ARWINE)
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